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In re application of
Helmut Moehwald : DECISION ON
Serial No. 09/674,541 : PETITION
Filed: November 2, 2000
For: COMPOSITION SUITABLE FOR ELECTROCHEMICAL CELL

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed December 4, 2002.

On June 19, 2002, a first office action was mailed to Applicants, rejecting all of the pending claims under 35 USC 112, second paragraph as being indefinite. Applicants responded to this office action with a response filed on October 23, 2002. A final rejection was then mailed December 4, 2002. A response was filed by Applicants to the final rejection on April 8, 2003 and an advisory action was mailed by the office on April 16, 2003. Applicants also requested in the response after final that the finality of the December 4, 2002 be withdrawn because it was improper.

On April 28, 2003, the instant petition under 37 CFR 1.181 was filed to formally request the withdrawal of finality of the December 4, 2002 office action. It is noted that an original request for the withdrawal of finality was submitted by Applicants on April 8, 2003 which falls more than two months after the date of the final rejection. A review of the prosecution history of the instant application reveals that no clear issue has been developed between the examiner and applicant and therefor this application is not ripe for appeal. Accordingly, the instant petition will be considered on its merits.

Petitioner's position for the withdrawal of the finality is that the new grounds of rejection applied in the final office action were not necessitated by Applicant's amendments to the claims. In addition it is the position of Petitioner that the final office action was incomplete.

DECISION

Section 706.07 of the MPEP states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding

all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

Furthermore, section 706.07(a) of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)..

First the argument by Petitioner that the new grounds of rejection were not necessitated by Applicant's amendments will be addressed. Specifically, the newly applied rejection of claim 14 based on "the compound Ib acts as cathode material" and "the compound acts as anode material" is urged to be a new ground of rejection not necessitated by Applicant's amendment because this language was originally present in the claims and not rejected in the first office action. This argument is persuasive. It is noted that the newly applied rejection over claims 27 and 28 was also not necessitated by Applicant's amendment to the claims. Amendments made to these claims did not make the claims indefinite and but merely changed the words "as claimed" to "defined." From a reading of the claims and the instant specification, these claims remained definite after amendment and should not have been newly rejected in the final office action. Once again, the rejection of these claims was not necessitated by Applicant's amendment.

Next, the other argument set forth by Petitioner that the final office action was incomplete will be addressed. It is noted that in the first office action, there was no mention of any prior art rejections over the claims. Additionally, there were no statements made by the examiner that the claims were so indefinite that no search of the claimed subject matter could be carried out and therefore, no prior art was being applied. In the final office action, the examiner makes a statement that "still no art has been cited." It appears on its face that this statement indicates that the instantly claimed subject matter has not been searched and/or rejections over any relevant prior art considered and applied. The instant claims do not appear to be so indefinite that a search and full examination could not take place. The specification contains several working examples and the claims appear to adequately set forth what is regarded as the invention. For this reason, it appears that the first action and then the final rejection were both incomplete. No clear issue has been developed at this stage in the prosecution.

Because the new grounds of rejection set forth in the final office action mailed December 4, 2002 were not necessitated by Applicant's amendments to the claims and because the final office action

was incomplete, said office action was improperly made final. Accordingly, the petition for withdrawal of finality is **GRANTED**.

The application is being forwarded to the examiner for entry and consideration of the amendment filed April 8, 2003. In addition, the examiner will prepare a new non-final office action addressing any appropriate prior art rejections in addition to any remaining 35 USC 112, second paragraph rejections.

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